

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

SECURE AXCESS, LLC,

vs.

U.S. BANK NAT'L ASS'N, *et al.*

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CIVIL ACTION NO. 6:13-CV-717

ORDER

Before the Court are the following motions and notice that arise out of 17 separate but related actions:

- Defendants U.S. Bank National Association's and U.S. Bancorp's Opening Brief in Support of Motion to Stay Proceedings Pursuant to Section 18(b) of the America Invents Act;¹
- Defendants Ally Bank and Ally Financial, Inc.'s Motion to Stay Proceedings and Opening Brief in Support;²
- Defendants GE Capital Retail Bank, GE Capital Bank, General electric Capital Corporation, and General Electric Company's Motion to Stay Proceedings³;
- Defendants Nationwide Bank, Nationwide Financial Services, Inc., Nationwide Corp., and Nationwide Mutual Insurance Company's Motion to Stay Proceedings Pursuant to Section 18(b) of the America Invents Act;⁴
- Defendants PNC Bank, National Association and the PNC Financial Services Group, Inc.'s Motion to Stay Proceedings Pursuant to Section 18(b) of the America Invents Act;⁵
- Defendants Santander Bank, N.A.'s Opening Brief in Support of Motion to Stay Proceedings Pursuant to Section 18(b) of the America Invents Act;⁶
- The Vanguard Group, Inc. and Vanguard Marketing Corporation's Notice of Non-Opposition to Stay Pending IPR and CBM;⁷

¹ Civil Action No. 6:13-cv-717, Docket No. 24.

² Civil Action No. 6:13-cv-718, Docket No. 32.

³ Civil Action No. 6:13-cv-720, Docket No. 39.

⁴ Civil Action No. 6:13-cv-721, Docket No. 31.

⁵ Civil Action No. 6:13-cv-722, Docket No. 31.

⁶ Civil Action No. 6:13-cv-723, Docket No. 23.

- Defendant Bank of the West's Opening Brief in Support of Motion to Stay Proceedings Pursuant to Section 18(b) of the America Invents Act;⁸
- Defendant Cadence Bank, National Association's Motion to Stay Pending CBM and/or IPR Review by the PTAB;⁹
- Defendants [Commerce Bank and Commerce Bancshares, Inc.'s] Motion to Stay Proceedings in this Case Under Section 18(b) of the America Invents Act;¹⁰
- Defendant Ocwen Financial Corporation's Motion to Stay Proceeding Pursuant to Section 18(b) of the America Invents Act;¹¹
- [Defendants Orange Savings Bank, SSB, First Financial Bank National Association, and First Financial Bankshares, Inc.'s] Motion for Joinder with Motions to Stay Filed in Related Cases;¹²
- Defendants Raymond James & Associates, Inc.'s and Raymond James Financial, Inc.'s Motion to Stay Proceedings and Opening Brief in Support;¹³
- Defendants [T. Rowe Price Investment Services, Inc., T. Rowe Price Associates, Inc., and T. Rowe Price Group, Inc.'s] Motion to Stay Pending CBM and/or IPR Review by the PTAB;¹⁴
- Defendants Trustmark National Bank and Trustmark Corporation's Joinder of Motions to Stay Filed in Related Cases;¹⁵ and
- [Third-Party Defendant] RSA Security LLC's Motion for Leave to Join Defendants' Motion to Stay Proceedings (collectively, "the Motions").¹⁶

Having considered the Parties' briefing, the Court **DENIES** the Motions **WITHOUT PREJUDICE**.

Plaintiff filed the above-styled consolidated patent infringement action alleging Defendants¹⁷ infringed U.S. Patent Number 7,631,191 ("the '191 Patent"). On March 4, 2014,

⁷ Civil Action No. 6:13-cv-724, Docket No. 50.

⁸ Civil Action No. 6:13-cv-779, Docket No. 22.

⁹ Civil Action No. 6:13-cv-780, Docket No. 30.

¹⁰ Civil Action No. 6:13-cv-782, Docket No. 27.

¹¹ Civil Action No. 6:13-cv-783, Docket No. 22.

¹² Civil Action No. 6:13-cv-784, Docket No. 28.

¹³ Civil Action No. 6:13-cv-785, Docket No. 27.

¹⁴ Civil Action No. 6:13-cv-787, Docket No. 31.

¹⁵ Civil Action No. 6:13-cv-788, Docket No. 21.

¹⁶ Civil Action No. 6:13-cv-717, Docket No. 45.

third-parties EMC Corporation and RSA Security, LLC filed a petition for *inter partes* review of the ‘191 Patent.¹⁸ The Patent Trial and Appeal Board (“PTAB”) is required to determine whether or not to grant the petition within six months of filing. On March 28, 2014, Defendants PNC Bank, N.A. and U.S. Bank, N.A. filed a petition for post-grant review under the Transitional Program for Covered Business Review (“CBM Review”) of the ‘191 Patent.¹⁹ The PTAB is required to determine whether or not to grant such petitions within six months of filing.²⁰ Accordingly, the PTAB will not issue a ruling on whether or not to institute an *inter partes* review until on or before September 2, 2014; and not until on or before September 28, 2014 for the petition requesting CBM review. Defendants seek to stay all proceedings in this case pending such a ruling from the PTAB.

While this case is still in its early stage, the PTAB proceedings are at an even earlier stage. It will take the PTAB up to six months from the petitions’ filing to determine whether or not to institute a *inter partes* review or CBM review. Therefore, the Court hereby **DENIES** the Motions **WITHOUT PREJUDICE**. Defendants may re-urge their Motions if warranted by further developments at the PTAB.

¹⁷ Plaintiff filed a separate but related action against Defendants Charles Schwab Bank and Charles Schwab Corporation, which was consolidated into the above-styled action. Defendants Charles Schwab Bank and Charles Schwab Corporation did not file a request to stay their case pending the PTAB’s decision. *See* Civil Action No. 6:13-cv-781.

¹⁸ *See*, Civil Action No. 6:13-cv-171, Docket No. 28 at 3; Civil Action No. 6:13-cv-780, Docket No. 30 at 3.

¹⁹ Civil Action No. 6:13-cv-717, Docket No. 24 at 1; Civil Action No. 6:13-cv-721, Docket No. 31 at 1.

²⁰ *See*, 35 U.S.C. §§ 323 and 324; *see also*, 37 C.F.R. §42.107 (providing patent owners up to three months after receiving notice of a petition to file an optional preliminary response); 35 U.S.C. §314 (requiring the PTAB to decide whether or not to institute an *inter partes* review within three months of the patent owner’s preliminary response or within three months of the time the preliminary response is due if the patent owner waives the preliminary response); 35 U.S.C. §316 (requiring the PTAB to issue a final decision on the *inter partes* review within one year of its decision to institute the proceeding and allowing the PTAB to extend the *inter partes* review proceeding for six months, if good cause is shown).

So ORDERED and SIGNED this 26th day of June, 2014.



K. NICOLE MITCHELL
UNITED STATES MAGISTRATE JUDGE